SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 802

THE BLACK AND DECKER MANUFACTURING COMPANY,
Petitioner,

v.

THE PORTER-CABLE MACHINE COMPANY AND ROCKWELL MANUFACTURING COMPANY, *Respondents.*

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

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STATEMENT OF THE CASE

Petitioner's statement of the case must be rejected since it is, in the main, argumentative rather than factual as required by Rule 23(e) of the rules of this Honorable Court.

Respondents, manufacturers of power tools, brought this patent suit against Petitioner, a principal competitor, to prevent continuing unlicensed manufacture by Petitioner of a portable saber saw developed at great expense by Respondents, patented by Respondents and sold in substantial quantities by Respondents.

The vigor with which the case was contested is evidenced by the record which comprises almost eleven hundred pages of trial transcript and over a hundred exhibits, many of which are relatively complex mechanical devices explained in detail to the District Court by experts for both parties. The length and quality of the District Court's opinion led the Court of Appeals to remark (159 USPQ 66; — F.2d —):

> "Resolution of the issues in the case required and received painstaking study. Without a jury, the trial occupied six days; both experts and pragmatists gave evidence to the critical points of the claims."

In the briefs submitted to the District Court before and after the trial, as well as in the briefs submitted to the Fourth Circuit Court of Appeals, the parties, in a rare display of accord, advised the courts that the issue of validity of Respondents' patent was to be determined in accordance with this Honorable Court's decision in *Graham* v. *John Deere*, 383 U.S. 1. The District Court and the majority of the Fourth Circuit Court of Appeals quoted and strictly followed *Graham* on the issue of patentability.

Only the dissenting opinion in the Court of Appeals failed to refer to *Graham* or for that matter to any

decision or to any statute on the issue of the validity of Respondents' patent.

This petition is essentially a carbon copy of Petitioner's request for rehearing En Banc addressed to the Fourth Circuit Court of Appeals which the court quickly denied without opinion.

ARGUMENT

The petition fails utterly to present any "special and important reason" for granting the writ and thus fails to meet the basic requirements of Rule 19 of this Honorable Court.

Question I

Petitioner's "QUESTION I" purports to raise an issue of importance. But this is illusory. Petitioner asks:

> "Can a patent lawfully be adjudged valid by a U. S. Court of Appeals on the *sole basis* of *fact findings* * * * ?"

The question attributes to the Court of Appeals an appellate technique which the court simply did not employ. While the Court of Appeals paid due respect to the District Court's findings of fact, noting particularly the judicial scrutiny and deliberation from which the District Court's findings evolved, the Court of Appeals nevertheless expressly reserved for its own decision the ultimate question of law. The Court of Appeals stated (159 USPQ 66; — F.2d —):

> "From these foundation facts, patentability of the device in suit soundly follows as a conclusion of law and the declaration of infringement must also be upheld."

The Court of Appeals also noted with approval that (159 USPQ 66; — F.2d —):

> "The (Trial Court's) pattern for decision prescribed in *Graham* v. *Deere,* supra, 383US1 was pursued almost ad verbum. The primary inquiries there directed were exhausted by the District Judge who arrayed and measured the evidence on each."

Questions II & III

Petitioner's Questions II & III are nothing more than the expression of an unsuccessful litigant's dissatisfaction with the result reached by the court below. Patently, they present no special or important reason for granting this writ.

The Asserted Conflict

Petitioner's position in asserting a conflict between the circuits, is predicated on the differences in the manner in which the Courts of Appeals articulate their views. Petitioner, however, overlooks the substantive agreement of the Courts of Appeals, consonant with this court's decision in *Graham,* supra, that the ultimate issue, whether it be labeled validity, patentability or something else, is a question of law fully reviewable by the Courts of Appeals. The Courts of Appeals are also in agreement, again in complete harmony with this court's decision in *Graham,* that the conditions for patentability lend themselves to basic factual inquiries, the painstaking resolution of which by the District Court is to be respected by the Courts of Appeals, absent clear error.

CONCLUSION

For the foregoing reasons we respectfully suggest that this case presents no issue of special importance, the resolution of which requires drawing on the resources and time of this Honorable Court. We accordingly respectfully suggest that the petition be denied.

Respectfully submitted,

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Certificate of Service

Service of this Respondents' Brief in Opposition to Petition for Writ of Certiorari has been made on petitioner by mailing, postage prepaid, to Theodore S. Kenyon, 59 Maiden Lane, New York, N. Y. 10038, Benjamin C. Howard, Miles & Stockbridge, 10 Light Street, Baltimore, Maryland 21202, C. Willard Hayes, Cushman, Darby & Cushman, American Security Bldg., Washington, D. C. 20005, on January 3, 1969.

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